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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,156	04/16/2004	Marc C. Zeitoun	082086-0305371	7855

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EXAMINER

KYLE, CHARLES R

ART UNIT PAPER NUMBER

3624

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/825,156

Applicant(s)

ZEITOUN ET AL.

Examiner

Charles R Kyle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date April 16, 2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. They recite the phrase “and/or” which makes it unclear whether the claim limitation is met only by a user capability to search, or whether other recited functions are required. The metes and bounds of the claim are unclear.

Claims 13-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. They recite “Investor/Goal Manager” and “Profile/Asset” screens, the nature of which is unclear.

Claims 21-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. They recite the phrase “a method for generating outputting...”. It is unclear what “generating outputting” would be.

Claim 23 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It recites the phrase “further comprising receiving analyzing...”. It is unclear what “receiving analyzing” would be.

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Claim 23, a method Claim, also depends from Claim 1, a system Claim. For purpose of examination, it is assumed that Claim 23 should depend from Claim 22.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-2, 5-6, 8-9, 12, 22-23, 26-27, 29 and 32-33 are rejected under 35 U.S.C. 102(a) as being anticipated by US 5,918,217 *Maggioncalda et al.*

As to Claim 1, *Maggioncalda* discloses the invention as claimed including in a system configured to output financial investment advice regarding investments in an investment portfolio (Abstract) associated with a designated goal based, at least, on an investor's risk and investment profile data information provided by a user (Col. 13, line 9 to Col. 14, line 47, particularly Col. 13, lines 59-64; Fig. 8), the system comprising:

a front-end (Col. 6, lines 25-29) including a plurality of graphical user interfaces configured to receive a user's identification of an investor's risk and investment profile data (Col. 10, line 31 to Col. 11, line 18; Figs. 4, 5b, 9, 12a and 12b);
and

a back-end (Col. 6, lines 25-29) configured to, at the direction of the user via the front-end, identify one or more recommended investments, and an allocation of funds among those

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investments (Col. 9, lines 29-62; Fig 4; ele. 430; Fig 13), based on the investor's risk and investment profile, a time horizon and a type of the designated goal). (Col. 13, line 9 to Col. 14, line 47, particularly Col. 13, lines 59-64; Fig. 8).

Regarding Claim 2, *Maggioncalda* further discloses data input and analysis with respect to an investment marketplace at Abstract and Col. 7, line 8 to Col. 8, line 3, and allocation of funds based on recited parameters at Fig. 8 and Col. 13, line 9 to Col. 14, line 47.

Concerning Claim 5, *Maggioncalda* discloses goals of education of a child and purchasing a home at Col. 13, lines 52-55.

Regarding Claim 6, *Maggioncalda* discloses a warning at Col. 13, lines 9-42 and Fig. 7c.

With respect to Claim 8, *Maggioncalda* discloses an investment proposal at Fig. 4, eles. 430 and 420.

With respect to Claim 9, *Maggioncalda* discloses a goal-based calculator at Fig. Col. 1, lines 38-48.

Regarding Claim 12, *Maggioncalda* discloses quantification of a goal at Fig. 4, ele. 420, "goal of \$117,849 in retirement at age 65".

Regarding Claims 22-23, they are method forms of Claims 1 and 2 and are rejected in a like manner.

Regarding Claims 26-27, see the discussion of Claims 22 and 5-6.

Regarding Claims 29, see the discussion of Claims 22 and 8.

Regarding Claim 32-33, see the discussion of Claims 22 and 12.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,918,217 *Maggioncalda et al.*

Regarding Claim 7, *Maggioncalda* discloses the invention substantially as claimed. See the discussion of Claim 1. *Maggioncalda* does not specifically disclose consideration of the recited rates of return and standard deviation. Official Notice is taken that it was old and well known at the time of the invention to consider such information in investment advisory processes. For example, the recited rates were indicators of investments as value or growth investments and standard deviation was an indicator of volatility of an investment. It would have been obvious to one of ordinary skill in the art at the time of the invention to include these considerations in the investment advisory method of *Maggioncalda* because this would make for improved quality of investment advice. See *Maggioncalda* at fig 5a.

Claim 28 is a method form of Claim 7 and is rejected in a like manner.

Claims 3-4, 10-11, 13-21, 24-25, 30-31 and 34-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,918,217 *Maggioncalda et al* in view of US 6,430,542 *Moran*.

As to Claim 3, *Maggioncalda* discloses the invention substantially as claimed, including outputting via the front-end data indicating recommended potential investments for an investment portfolio associated with a designated goal. See Fig. 4 and related text. See also the discussion of *Maggioncalda* does not specifically disclose that the system recognizes relationships between multiple investors. *Moran* discloses this limitation at Fig. 10 and Col. 12, lines 53-64. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Maggioncalda* to include the recognition of relationships among investors in investments disclosed by *Moran* because this would consider the economic effects of portfolio decisions on related groups rather than disparate individuals. See *Moran* at Col. 12, lines 56-64.

Concerning Claim 4, *Moran* discloses a husband/wife relationship at Col. 12, line 59.

Regarding Claim 10, *Moran* discloses an entry port screen having links to navigational icons that trigger associated screens at Fig. 3. It would have been obvious to one of ordinary skill in the art at the time of the invention to include the entry screen of *Moran* in the method of *Maggioncalda* because this would provide a logical point to begin the advisory process and give access to successor functions.

With respect to Claim 11, *Moran* discloses successor options at Fig. 2, eles. 77-79.

As to Claim 13, *Maggioncalda* further discloses a Recommended Purchase screen at Fig. 4, ele. 430. *Moran* discloses an Investor/Goal Manager screen at Fig. 17, an Asset Allocation screen at Fig. 23, a Portfolio Analytics screen at Fig. 12 and a proposal Generation screen at Fig. 45. It would have been obvious to one of ordinary skill in the art at the time of the invention to add the screens disclosed by *Moran* to those of *Maggioncalda* because this would provide fuller functionality for the advisory method of *Maggioncalda*.

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With respect to Claim 14, see *Moran* at Figs. 10-27. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Maggioncalda* with the creation of investors groups and account addition functions disclosed by *Moran* because this would allow advisors to customize information on investors for the advisory process.

Concerning Claim 15, *Moran* discloses consideration of progress to a goal at Col. 2, lines 11-30.

With respect to Claim 16, *Maggioncalda* discloses review of mutual funds at Fig. 5a and Col. 10, lines 20-30.

Concerning Claim 17, Official Notice is taken that customization of proposals for particular customers by selecting subsets of data was old and well known at the time of the invention. For example, an advisor might wish to provide a greater number of exhibits for the more detail-oriented customer. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Maggioncalda* with this feature to provide proposals most accessible to each customer.

Concerning Claims 18-20, *Maggioncalda* discloses a General Asset Allocation report associated with a designated goal at Figs. 5a, 12a, 12b, 14a and 14b. See also Col. 3, lines 29-60, Col. 8, line 5 to Col. 9, line 62 and Col. 16, lines 26-67.

As to Claim 21, *Maggioncalda* discloses a retirement module at Col. 18, lines 26-38.

Regarding Claims 24-25, they are method forms of Claims 3 and 4 and are rejected in a like manner.

Claim 30 is a method form of Claim 10 and is rejected in a like manner.

Claim 31 is a method form of Claim 11 and is rejected in a like manner.

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Concerning Claims 34-35, see the discussion of Claims 32 and 13.

Regarding Claims 36-40, see the discussion of the respective Claims from which they depend and Claims 15-17 and 19-20.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles R Kyle whose telephone number is (571) 272-6746. The examiner can normally be reached on M-F 6:00-2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent A. Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

crk
May 17, 2005

Examiner Charles Kyle

